

REMARKS

Claims 12-22 are pending.

The instant office action restricts Applicants to one of two groups of claims. These groups are shown in the table below.

Group	Claims	Description Provided in the Office Action
I	12-19 and 22	composition of a nucleic acid mimic of formula I, classified in class 514, subclass 02
II	20 and 21	nucleic acid mimic of formula IIIa, classified in class 530, subclass 350

Applicants elect Group I with traverse. According to MPEP § 803, there are two criteria that both must be met for a proper requirement for restriction between patentably distinct inventions:

- (A) the inventions must be independent (see MPEP § 802.01, § 806.04, § 808.01) or distinct as claimed (see MPEP § 806.05 to § 806.05(i)); and
- (B) there must be a serious burden on the examiner if restriction is not required (MPEP § 803.02, § 806.04(a) to § 806.04(i), § 808.01(a), and § 808.02).

The claims of Groups I and II, however, are not independent and distinct, nor will searching them together impose a serious burden on the examiner. The structures recited in claims 20 and 21, for example, are within the scope of the chemical structure recited in claim 22. As such, examination of Group I will necessarily include review of materials having the scope of

claim 20 and 21. Accordingly, there is no basis for the proposed restriction.¹

The Office Action also requires that Applicants elect a single disclosed species. In making this requirement, the Office Action alleges that the claims are directed to patentably distinct species of nucleic acid mimics. Applicants question the requirement for a species election. M.P.E.P. § 802.01 defines "distinct" species as those that "ARE PATENTABLE (novel and unobvious) OVER EACH OTHER." (emphasis original). See also, M.P.E.P. § 806.04(h) and 808.01(a). Accordingly, a conclusion that each of the nucleic acid mimic species are patentably distinct from one another would establish a standard for patentability to be employed throughout prosecution of this patent application (including in any assessment of the non-obviousness of the claimed subject matter in view of the prior art) whereby species that, for example, differ only with respect to a single difference in a variable in the generic structure must be found unobvious in view of one another. In the event that the species election requirement is maintained, Applicants elect the species designated PNA3 (Sequence ID No. 5) which can be found on page 20, line 1 to page 21, line 4.

¹ Applicants also note that claims 20 and 21 are not duplicates as alleged in the Office Action (page 2). These claims differ in at least the group that links the "L" group to the molecule backbone.

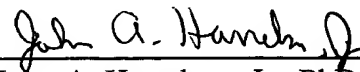
DOCKET NO.: ISIS-2447
Application No.: 09/142,326
Office Action Dated: December 29, 2005

PATENT

Applicants believe the foregoing constitutes a complete response to the Office Action and submit that all pending claims are in condition for ready allowance. An early Office Action to that effect is, therefore, earnestly solicited.

Respectfully submitted,

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